REMARKS

Applicants have amended claims 3, 6, 8, 11 and 12 by deleting the preferred limitations and reintroducing them in new claims 17-21. Support for the amendment to claim 16 can be found in the Specification on page 13, Example 11 and page 2, lines 12-21. Lastly, Applicants have incorporated claims 6 and 8 into claim 1. No new matter has been added.

Claim Objections

The Examiner has objected to claims 6-12 as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claims. The Examiner indicates that claims 6-12 have therefore not been further treated on the merits. Applicants respectfully traverse.

Applicants respectfully submit that the Examiner has failed to consider a Preliminary Amendment #3 that was filed July 18, 2001 which corrects the claim format and eliminates the multiple dependencies. The USPTO Patent Application Information Retrieval (PAIR) site indicates that the Preliminary Amendment was received and entered on August 13, 2001. We enclose a copy of the information available on PAIR for this application. Applicants therefore respectfully request that the Examiner duly examine claims 6-12. Applicants also note that the claim set provided with this application correctly notes the dependencies that had been previously amended.

Rejections Under 35 U.S.C § 112, second paragraph

The Examiner has rejected claim 16 as being indefinite, indicating that the claim does not set forth any steps involved in the method/process making it unclear what method/process is encompassed. The Examiner notes that this claim is also rejected under 35 U.S.C § 101 because a claimed recitation of use without setting forth any steps involved in the process is improper.

Applicants have amended claims 16, setting forth clear steps in the method for forming films, thereby obviating the rejection. OK

The Examiner has rejected claims 3 and 8 as vague due to the recitation of a broad range or limitation followed by a linking term and a narrow range or limitation.

Applicants have amended claims 3 and 8 by removing the preferred limitation and introducing it in a new, dependant claim. Applicants also note that they reviewed the remaining claims, finding a similar situation for claims 6, 11 and 12. Applicants therefore have also corrected these claims by removing the preferred limitation and re-introducing it in a new dependant claim. Applicants thus submit that they have obviated the rejection.

Rejections Under 35 U.S.C § 103

The Examiner has rejected claims 1-5 and 14-15 as being unpatentable over Corcoran (USP 4,816,500). The Examiner contends that Corcoran discloses a coating composition comprising a binder containing (a) 50-95% by weight of an acrylic polymer and (b) 5-50% by weight of a glycidyl component and 0.1-5% of a catalyst. The Examiner notes that acrylic polymers are described and that the glycidyl component

reads on the claimed coalescent agent of instant claim 1. In addition, the Examiner contends that composition containing 20-80% by weight of binder are also disclosed and that the examples show the compositions form hard films on drying. The Examiner then concludes that it would have been obvious to follow the teachings of Corcoran to arrive at the instant invention. Applicants respectfully traverse.

Corcoran discloses the uses of glycidyl components having two or more glycidyl groups as binders in coating compositions. The instant application, on the other hand, now claims monoglycidyl esters/ethers as coalescent agents in a binder composition. The Corcoran reference specifically states "a glycidyl component having at least two reactive glycidyl groups" (see column 2, lines 9-10 and column 3, lines 59-60). There is no teaching or suggestion in Corcoran that monoglycidyl esters/ethers are suitable or desirable. Thus, Applicants respectfully request reconsideration and removal of the rejection.

The Examiner has rejected claim 13 as being obvious over Corcoran in view of Leibelt et al. (USP 6,008,273). The Examiner's interpretation of Corcoran is discussed above. The Examiner contends that Leibelt discloses coating compositions in which some volatile organic compounds, such as phenyl ether of ethylene glycol, can be used. The Examiner then concludes that it would have been obvious to add the compound of Leibelt to the composition of Corcoran to obtain the instant invention. Applicants respectfully traverse.

As discussed above, Corcoran neither discloses nor suggests the use of monoglycidyl esters/ethers as coalescent agents in a binder composition. The Leibelt reference does not fill this void. Leibelt, too, discloses only diglycidyl ethers and neither

teaches nor suggests the use of monoglycidyl ethers/esters. Thus, Applicants respectfully request reconsideration and removal of the rejection.

All of the claims remaining in the case including newly added claims are submitted to define novel, non-obvious, patentable subject matter.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Leonard R. Svensson (Reg. No. 30,330) at 714-708-8555 in Costa Mesa, CA, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachments: Print Out – PAIR Transmittal

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope to: Commissioner of Patents and Trademarks, Washington D.C. 20231 on: April 22, 2003
(Date of deposit)

BIRCH, STEWART, KOLASCH & BIRCH, LLP

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(Signature)

April 22, 2003
(Date of Signature)